

REMARKS

In an Office Action mailed on August 18, 2003, the Examiner withdrew the finality of the previous final office action (thereby removing the application from appeal); rejected claims 1-4 and 6 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) as being obvious in view of Bonnefoy; rejected claims 5 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Bonnefoy in view of the European Publication EP 782209 (herein called the "EP publication"); rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Bonnefoy in view of EP publication and further in view of Hauer; and rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Bonnefoy in view of the EP publication and Singh. Newly added claims 20-27 are patentable over the cited art. The §§ 102 and 103 rejections are addressed below.

As pointed out in the previous replies and in the Appeal Brief, Bonnefoy fails to teach all limitations of claim 1, such as the determining and selective routing of claim 1. In the latest Office Action, the Examiner contends that the limitations (of independent claim 1) that are not explicitly taught in Bonnefoy are somehow inherent in Bonnefoy. However, for a missing claim limitation to be inherent in a reference, the limitation must necessarily flow from the reference. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). This is not case here, as Bonnefoy teaches hard wiring the battery in place so that the battery takes excess profit from excess electric energy. It appears that in reaching the conclusion that the missing claim limitations are allegedly inherent in Bonnefoy, the Examiner is selectively reading portions of claim 1 instead of considering the claim language in its entirety.

More specifically, turning to the language of claim 1, claim 1 recites, "in response to a decrease in at least one of the power produced by the fuel cell stack and the power consumed by the first load, determining . . ." Thus, claim 1 recites that the determination occurs *in response to* the decrease in power (emphasis added). Although the Examiner goes at some length to recite various design criteria, etc., that may be involved in the design of Bonnefoy's circuit, there is no teaching, suggestion or necessary implication in Bonnefoy that a determination is made *in response to* a decrease in power. Rather, the battery of Bonnefoy takes excess energy due to its

hard wiring, not in response to some determination that energy is decreasing. Although the circuitry of Bonnefoy may have been designed at some point in response to some determination of how the circuit should behave when power to the load decreases, the selective routing of energy to the battery of Bonnefoy does not occur *in response to* determining whether a power to a load has decreased. Therefore, when the claim language is considered in its entirety, Bonnefoy fails to explicitly, implicitly or inherently teach the determination and selective routing of claim 1.

Additionally, the Examiner fails to establish a *prima facie* case of obviousness for independent claim 1 for at least the reason that the Examiner fails to show where the prior art teaches or suggests the missing claim limitations. M.P.E.P. § 2143. *See Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143.

Therefore, for at least the reasons set forth above, claim 1 overcomes the §§ 102 and 103 rejections. Claims 2-8 and 19 are patentable for at least the reason that these claims depend from an allowable claim.

CONCLUSION

In view of the foregoing, Applicant requests withdrawal of the §§ 102 and 103 rejections and a favorable action in the form of Notice of Allowance. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (PUG.0056US).

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Respectfully submitted,

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